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09/922,240	08/03/2001	Michael A. Greenberg	1250/4	8715
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* MICHAEL A. GREENBERG,
9 CHRISTIAN A.S. PENZA,
10 and
11 PATRICK ZAOUTER
12

13
14 Appeal 2008-004049
15 Application 09/922,240
16 Technology Center 3600
17

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19 Decided:¹ June 29, 2009
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22 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
23 ANTON W. FETTING, *Administrative Patent Judges*.

24
25 CRAWFORD, *Administrative Patent Judge*.
26
27

28 DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented systems and methods for online purchasing and selling of commodities from business to business (Spec. 1:14-16).

Claim 1, reproduced below, is further illustrative of the claimed subject matter:

1. A method for providing a commodity offer price to a buyer, comprising:
receiving an offer to sell a commodity according to a predetermined contract at a specified price;
adjusting the specified price based on shipping costs for shipping the commodity from the seller to the buyer; and
transferring the adjusted price to the buyer over a computer network for displaying by a remote client.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Walker	US 5,794,207	Aug. 11, 1998
O'Neill	US 6,219,653 B1	Apr. 17, 2001
Pool	US 6,460,020 B1	Oct. 1, 2002

The Examiner rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Pool; and rejected claims 4-30 under 35 U.S.C. § 103(a) as being unpatentable over O'Neill.

We AFFIRM-IN-PART.

ISSUES

Did the Appellants show the Examiner erred in finding motivation to combine Walker and Pool to render obvious the subject matter of claims 1-3, because Walker teaches away from adjusting the specified price in the offer from the buyer?

Did the Appellants show the Examiner erred in finding that a proper prima facie case has been established that O'Neill renders obvious means for matching the bid to the offer to generate a transaction, as recited in independent claim 13?

Did the Appellants show the Examiner erred in finding that O'Neill discloses adjusting bids/offers/prices based on shipping costs prior to completion of the sales transaction, as required by claims 4-12 and 14-30?

FINDINGS OF FACT

Specification

Appellants invented systems and methods for businesses to purchase and sell commodities online (Spec. 1:14-16).

Walker

Walker discloses a method and apparatus for effectuating bilateral buyer-driven commerce (Abstract).

Prospective buyers of goods or services communicate a binding conditional purchase offer (CPO) globally to potential sellers over an electronic network. Sellers conveniently search for relevant buyer purchase offers on the electronic network and bind a buyer to a contract based on the buyer's purchase offer (col. 8, ll. 28-44).

The providers of the electronic network could derive a revenue stream, for example, by charging a flat fee to the buyer for every submitted CPO (col. 20, ll. 16-18).

The CPO may specify that the price offered is excluding tax (col. 31, ll. 22, 31).

O'Neill

O'Neill discloses a freight calculation system and method of operation (col. 1, ll. 16-18).

A user of buyer client 22 may review a generated market order prior to communicating a buy query to platform 18. In particular, buyer client 22 may enter freight calculation data in Delivery Information field 494 to be used by platform 18 to determine delivery costs. The buy query, including the delivery information, is then communicated to platform 18 (Fig. 13H; col. 26, ll. 23-40).

Platform 18 then generates offers from multiple seller clients 24 based on the buy query. The offer may include delivery information such as freight costs. The user of buyer client 22 may then initiate a buy request by selecting a business location of a particular seller client 24, from which buyer client 22 will buy the selected product, by activating Buy button 428 (Fig. 13I: col. 27, ll. 13-27).

PRINCIPLES OF LAW

A reference teaches away when a person of ordinary skill, upon examining the reference, would be discouraged from following the path set

1 out in the reference, or would be led in a direction divergent from the path
2 that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir.
3 1994).

4
5 ANALYSIS

6 *Teaching Away*

7 We are not persuaded of error on the part of the Examiner by
8 Appellants' argument that there was no motivation to combine Walker and
9 Pool to render obvious the subject matter of claims 1-3, because Walker
10 teaches away from adjusting the specified price in the offer from the buyer
11 (Appeal Br. 11-12; Reply Br. 10). While Walker does generally disclose
12 buyers submitting binding CPOs, Walker does not discourage adjusting the
13 specified price in the offer from the buyer as required for a teaching away.
14 See *In re Gurley*, 27 F.3d at 553. Indeed, Walker is silent about the seller's
15 adjustment of the specified price in the CPO, and silence is not
16 discouragement. If anything, Walker acknowledges that the price may be
17 adjusted, for example, by the imposition of a user fee by the electronic
18 network or by the addition of applicable taxes to the CPO.

19
20 *Matching Bids*

21 We are persuaded of error on the part of the Examiner by Appellants'
22 argument that the Examiner has not provided a proper prima facie case as to
23 how O'Neil renders obvious means for matching the bid to the offer to
24 generate a transaction, as recited in independent claim 13 (Appeal Br. 12-16;
25 Reply Br. 11-12). The Examiner has generally lumped in the rejection of
26 independent claim 13 with the rejection of claims 4-12 and 14-30

(Examiner's Ans. 4-5, 6-7). However, independent claim 13 recites subject matter different from claims 4-12 and 14-30. Specifically, independent claim 13 recites "means for matching the bid to the offer to generate a transaction." The Examiner has not specifically mentioned this aspect of claim 13 anywhere in the Examiner's Answer. Accordingly, as this aspect has not been specifically addressed, a prior prima facie case of obviousness has not been established, and thus the rejection of independent claim 13 cannot be sustained.

Shipping Costs Prior to Completion of Sale

We are not persuaded of error on the part of the Examiner by Appellants' argument that O'Neill does not disclose adjusting bids/offers/prices based on shipping costs prior to completion of the sales transaction, as required by claims 4-12 and 14-30 (Appeal Br. 12-16; Reply Br. 11-12). Fig. 13I of O'Neill discloses freight costs for each offer (under "Weight" and above a date) prior to a user of buyer client 22 pressing Buy button 428 to complete the sales transaction.

CONCLUSION

The Appellants have failed to show that the Examiner erred in rejecting claims 1-12 and 14-30.

The Appellants have shown that the Examiner erred in rejecting claim 13.

DECISION

The decision of the Examiner to reject claims 1-12 and 14-30 is affirmed.

The decision of the Examiner to reject claim 13 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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